



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,731	07/03/2003	Gerald A. Hutchinson	APTPEP1.048A	7527

20995 7590 10/05/2009
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

LIGHTFOOT, ELENA TSOY

ART UNIT	PAPER NUMBER
----------	--------------

1792

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/05/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No. 10/614,731	Applicant(s) HUTCHINSON ET AL.	
	Examiner Elena Tsoy Lightfoot	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,16-19,52,53,58-63,65-82 and 84-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14,16-19,52,53,58-63,65-82 and 84-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/14/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Amendment filed on August 7, 2009 has been entered. Claims 2, 57, and 83 have been cancelled. Claims 1, 3-14, 16-19, 52, 53, 58-63, 65-82, and 84-95 are pending in the application.

Claim Objections

1. Objection to claims 10-11 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn due to amendment.
2. Objection to claim 18 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn due to amendment.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3-9, 12, 14, 16-18, 52, 53, 58-60, 62, 63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-38 of U.S. Patent No. 6,676,883 in view of Dworak et al (US 6,350,796), further in view of Geist et al (US

Art Unit: 1792

4762903) for the reasons of record set forth in paragraph 4 of the Office Action mailed on 4/1/2008 because the amendment incorporates limitations of currently cancelled claims.

5. Claims 68-71, 74, 75, and 77 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-38 of U.S. Patent No. 6,676,883 in view of Dworak et al, further in view of Geist et al, and further in view of Mallya et al (US 6489387) for the reasons of record set forth in paragraph 14 of the Office Action mailed on 8/8/2007.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-12, 14, 16-19, 52-53, 58-63, and 65-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi (US 4,393,106) in view of Farha (US 5,472,753), further in view of Noda (US 6,872,802), further in view of Dworak et al, and further in view of Geist et al (US 4762903) for the reasons of record set forth in paragraph 7 of the Office Action mailed on 4/1/2008 because the amendment incorporates limitations of currently cancelled claims.

8. Claims 1, 3-12, 14, 16-19, 52-53, 58-63, and 65-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi (US 4,393,106) in view of Farha (US 5,472,753), further in view of Noda (US 6,872,802), and further in view of Geist et al for the reasons of record set forth in paragraph 8 of the Office Action mailed on 4/1/2008 because the amendment incorporates limitations of currently cancelled claims.

9. Claims 8, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, further in view of Dworak et al, and further in view of Geist et al, and further in view of Cobbs, Jr et al (US 4,573,429) for the reasons of record set forth in paragraph 17 of the Office Action mailed on 8/8/2007.

10. Claims 8, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, and further in view of Geist et al, and further in

Art Unit: 1792

view of Cobbs, Jr et al (US 4,573,429) for the reasons of record set forth in paragraph 17 of the Office Action mailed on 8/8/2007.

11. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, further in view of Dworak et al, and further in view of Geist et al, and further in view of Miyake et al (US 5079034) for the reasons of record set forth in paragraph 18 of the Office Action mailed on 8/8/2007.

12. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, and further in view of Geist et al, and further in view of Miyake et al (US 5079034) for the reasons of record set forth in paragraph 18 of the Office Action mailed on 8/8/2007.

13. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, further in view of Dworak et al and further in view of Geist et al, and further in view of Kennedy (US 4,505,951) for the reasons of record set forth in paragraph 19 of the Office Action mailed on 8/8/2007.

14. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, further in view of Geist et al, and further in view of Kennedy (US 4,505,951) for the reasons of record set forth in paragraph 19 of the Office Action mailed on 8/8/2007.

15. Claims 80-82, 84-88, and 90-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, further in view of Dworak et al, and further in view of Geist et al, further in view of Kennedy, and further in view of Cobbs, Jr et al for the reasons of record set forth in paragraph 20 of the Office Action mailed on 8/8/2007.

16. Claims 80-82, 84-88, and 90-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, and further in view of Geist et al, further in view of Kennedy, and further in view of Cobbs, Jr et al for the reasons of record set forth in paragraph 20 of the Office Action mailed on 8/8/2007.

17. Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, further in view of Dworak et al, and further in view of Geist et al, further in view of Kennedy, further in view of Cobbs, Jr et al, and further in view of

Art Unit: 1792

Fagerburg et al (US 4499262) for the reasons of record set forth in paragraph 21 of the Office Action mailed on 8/8/2007.

18. Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maruhashi et al in view of Farha, further in view of Noda, further in view of Geist et al, further in view of Kennedy, further in view of Cobbs, Jr et al, and further in view of Fagerburg et al (US 4499262) for the reasons of record set forth in paragraph 21 of the Office Action mailed on 8/8/2007.

Response to Arguments

Applicants' arguments filed August 7, 2009 have been fully considered but they are not persuasive.

Declaration of Edward Socci

Applicants submit that both Oxybloc 670 C 1322-R and Oxybloc 670 C 1300-R include a thermoplastic polyhydroxyamino ether (PHAЕ) epoxy-amine polymer in combination with a blend of phosphoric and lactic acids. Oxybloc 670 C 1322-R has an acid content of 1.45% phosphoric acid and 1.95% lactic acid, for a total acid content of 3.40%. Oxybloc 670 C 1300-R has an acid content of 4.25% phosphoric acid and 0.75% lactic acid, for a total acid content of 5.00%. Using the CTR and OTR data, the CO₂ and O₂ permeability of these articles were calculated. The CO₂ and O₂ permeability data presented in the Declaration can be summarized as follows: Oxybloc 670 C 1300-R, which has more phosphoric acid than lactic acid, demonstrated reduced permeability to CO₂ and O₂ as compared to Oxybloc 670 C 1322-R, which has more lactic acid than phosphoric acid. The coating barrier improvement factor (BIF), which reflects the improvement in barrier capability of the coating in comparison with an uncoated article, was significantly greater for Oxybloc 670 C 1300-R, with respect to both CO₂ and O₂ transmission.

The Declaration is unconvincing because experimental data presented in the Declaration are **not commensurate** in scope with these claims:

(i) since the experimental data presented in the Declaration compare the total acid content of **5.00%** with total acid content of **3.40%**, it is not clear whether the gas transmission is reduced because of higher level of total acid or the higher ratio of phosphoric acid;

(ii) since claim 1 does not recite the critical amount of phosphoric acid, it is not clear whether the gas transmission would be still reduced at the content of phosphoric acid of e.g. 0.1% and the content of other acids of 0.02%, i.e. 5.7 times less than the amount of phosphoric acid as shown in the Declaration?

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/614,731

Page 7

Art Unit: 1792

Elena Tsoy Lightfoot, Ph.D.

Primary Examiner

Art Unit 1792

October 2, 2009

/Elena Tsoy Lightfoot/